



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,572	06/03/2005	Malcolm Reginald Hallas Bell	17178-002	3580

34313 7590 04/30/2008
ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

EXAMINER

HAGEMAN, MARK

ART UNIT	PAPER NUMBER
----------	--------------

3653

MAIL DATE	DELIVERY MODE
-----------	---------------

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,572

Applicant(s)

BELL ET AL.

Examiner

Mark Hageman

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 4-3-2006, 8-8-2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 13-24 in the reply filed on 4-4-2008 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities: In the abstract line 12 "succAn" is not understood it appear some letters etc. are missing. Para 0044 line "xf win occur" does not make sense, it appears it should read xf will occur. Para 0071 line 7 "as t" should read as it.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The term "relatively" in claim 13 is a relative term which renders the claim indefinite. The term "relatively" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the

art would not be reasonably apprised of the scope of the invention. It is not clear how the high and low acceptance regions are actually defined or where their boundaries lie.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13-24 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/48138 to Bell et al. Bell discloses a money item acceptor (p3 lines 25+) comprising: a signal source (p3 lines 27+) to produce a money item parameter signal as a function of a sensed characteristic of a money item, a store (p3 lines 28+) to provide data corresponding to a normal acceptance range of values of the parameter signal for a money item of a particular denomination, the range including relatively high and low acceptance probability regions wherein the value of a parameter signal corresponds to a relatively high or low probability of an occurrence of a sensed money item of said particular denomination, and a processor configuration (p3 lines 33+).

8. The language following "a processor configuration operable..." is considered functional for the reasons discussed below. The device of the Bell reference is readily capable of the functioning in the claimed manner and therefore anticipates the claims. The claim language regarding the processor configuration discusses determinations that are made in the processor but fails to manipulate or actually control the device

itself. Nothing in the claim actually links the processor configuration to a change that takes place in the structural elements of the device. Therefore the processor does not actually control the device or require any physical response by the recited structure. Outputs are discussed but these constitute electronic signals which are not patentable unless utilized in some way. For instance actually claiming some sort of accept/reject mechanism such that accepted coins are retained while rejected coins are returned or separately retained which is operated under the control of the signal would provide a link to the structure of the device and would show that the processor actually controls the device rather than just generating signals.

9. Examiner further notes the presence of multiple conditional statements in the claims. For instance "when an occurrence..." and "if the second occurrence..." As discussed in the restriction requirement dated 3-6-2008 Examiner notes that if both possible outcomes are not addressed these limitations fail to further limit the claim. For instance claim 13 states, "to determine when an occurrence of the parameter signal corresponding to a first money item adopts a first predetermined value relationship..." What happens when the parameter signal of the first money item never "adopts a first predetermined value relationship?" When this condition is not established the rest of the following claim language fails to provide any further limitation.

10. Examiner notes that these limitations are not required by the claims because the other possibility is not considered. For example a claim that states if A then B does not account for the if not A case and therefore in the not A case there is no limitation or result. Positively claiming both possible outcomes requires that claim perform some

Art Unit: 3653

action for either possible input and therefore requires the prior art to consider both possibilities. A claim stating if A then B and if not A then C is only anticipated by a reference that accounts for the proper response to both the A and not A cases in the claimed manner. A claim stating only if A then B only considers one situation and therefore fails to provide any limitation in the if not A case.

11. All of the dependant claims relate directly to the processor configuration and therefore as set forth above are functional. The Bell reference anticipates these claims as it is readily capable of functioning in the claimed manner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

MCH